REMARKS

Claims 24, 28 and 32 have been amended. Claims 1-39 are pending in the application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration. In this regard, the Examiner offered comments in reply to arguments that were presented in Applicants' last Response. The Examiner's comments are addressed in the remarks that follow.

Claim Objections

The Office Action objected to Claims 24, 28 and 32, noting an inadvertent typographical error in each claim. The foregoing amendments correct the indicated errors. These amendments merely correct typographical errors, and do not alter the intended scope of any claim.

Independent Claim 1 and Fromherz

Independent Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by Fromherz U.S. Published Application No. 2004/0225394. This ground of rejection is respectfully traversed, for the following reasons.

Applicants' Claim 1 includes limitations reciting that:

> if said current product lot has a high priority, determining if a previous product lot remains in a selected unit of said processing equipment,
>
> if said previous product lot remains in the selected unit of processing equipment, determining if said previous product lot ~~is~~ has a normal priority;

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if said previous product lot has a normal priority, removing said previous product lot from said selected unit of processing equipment,

processing the current product lot with the high priority; and

upon completion of processing said current product lot with high priority, continuing processing the previous product lot.

MPEP §2121.01 specifies that it is not sufficient for an assertedly anticipating reference to merely mention the claimed subject matter, because it is a requirement under §102 that the reference must provide an "enabling" disclosure of that subject matter. Here, Fromherz includes vague and passing mention (for example in paragraph 13) of the idea of interrupting a partially completed job within a system controller, and then later restarting that job. However, with reference to the drawings and the text describing them, it does not appear that Fromherz's preferred embodiment includes this capability, and Fromherz never provides any detailed description of how to interrupt and restart a job within a system controller. Fromherz mentions in paragraph 13 that some jobs can be interrupted and restarted correctly, and that others cannot, but Fromherz fails to provide any detail about how an automated system would decide which jobs can be interrupted and restarted and which cannot. Moreover, as to those jobs that can be successfully interrupted and restarted, Fromherz fails to provide any detail about the specific sequence of steps that an automated system would need to go through in order to actually interrupt and then later restart a job without any error. It is one thing to propose a concept, but it is another to actually provide an enabling disclosure of one particular way to actually build a device embodying that concept.

The Office Action argues that Fromherz does provide an enabling disclosure. As part of this, the Office Action argues at lines 13-19 on page 3 that a reference like Fromherz is presumed to be operable. However, operability is not the issue. In particular, operability and an enabling

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disclosure are two entirely different issues. It is possible for a reference to provide an enabling disclosure of a device that is not operable, and it is possible for a reference to provide a non-enabling disclosure of a device that is in fact operable. Moreover, the authority relied on by the Examiner deals with the issue of whether Fromherz provides a proper disclosure of the Fromherz invention, whereas Applicants' argument was that Fromherz does not provide a proper disclosure of Applicants' invention, as recited in Applicants' Claim 1. Contrary to the assertions in the Office Action, there is no presumption that Fromherz provides an enabling disclosure of Applicants' invention.

The Office Action then goes on to quote from MPEP §2121.01, indicating that in an assertedly anticipating reference, "mere naming or description of the [claimed] subject matter is insufficient, if it cannot be produced without undue experimentation". The Office Action then asserts that:

> the *entire disclosure* of Fromherz is directed to interrupting partially completed jobs with the system controller, including a plurality of conditions under which jobs can interrupt other jobs, based upon their respective priorities. One of ordinary skill in the art would easily, without undue experimentation, have provided for a sequence of comparison steps, specific to a particular implementation, in order to accomplish this result.

In essence, the Examiner argues that although Fromherz does not disclose any specific procedure, much less the specific step-by-step procedure that is expressly recited in the above-quoted limitations from Applicants' Claim 1, a person skilled in the art would be able to easily come up with some suitable step-by-step procedure, without undue experimentation. However, the Office Action does not assert that the person of ordinary skill would necessarily come up with Applicants' specific step-by-step procedure, as recited in Claim 1. Moreover, it is important to

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remember that the instant rejection is for anticipation under §102, not for obviousness under §103. Under §102, a reference must contain a clear disclosure of each and every element recited in Applicants' Claim 1. Provided that the reference discloses each and every recited element, then one may look to "undue experimentation" in order to evaluate whether the disclosed elements are all presented in sufficient detail to constitute an enabling disclosure. But where a reference fails to disclose each and every element of a claimed combination, then by definition there is no anticipation under §102, regardless of what a person skilled in the art might possibly be able to do without "undue experimentation". With reference to the Examiner's assertion here that a person "of ordinary skill in the art would easily, without undue experimentation, have provided for a sequence of comparison steps", there is an inherent recognition in the Office Action that Fromherz does not disclose the specific sequence of steps recited in Applicants' Claim 1. Fromherz thus does not anticipate Applicants' Claim 1 under §102.

Independent Claim 1 and Kashiyama

Independent Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by Kashiyama U.S. Patent No. 6,400,999. This ground of rejection is respectfully traversed, for the following reasons.

Applicants' last Response pointed out that Kashiyama does not disclose each and every element recited in Claim 1. For example, Claim 1 includes limitations that recite:

> removing said previous product lot from said selected unit of processing equipment,
>
> processing the current product lot with the high priority; and
>
> upon completion of processing said current product lot with high priority, continuing processing the previous product lot.

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Applicants pointed out that Kashiyama does not disclose all of these limitations. In the paragraph that bridges pages 4-5 of the Office Action, the Examiner asserts that Applicants are merely arguing semantics, adding that "There is no requirement, in order for a reference to be anticipatory, that the reference utilize the exact same terminology, as used by Applicant, to describe the inventive concept". However, Applicants respectfully assert that this is not a matter of semantics. As one example, Kashiyama teaches that where a part is being processed under a first procedure (such as the procedure 234 at QA in Figure 14 of Kashiyama), there are circumstances where a higher-priority second procedure (such as 236) may take over and complete the processing of that particular part in a manner different from how the part would have been completed under the first procedure. But Kashiyama does not teach that processing of the part is ever interrupted, or that the part is ever removed from the processing equipment. Kashiyama thus does not teach every element recited in Applicants' Claim 1, such as "removing said previous product lot from said selected unit of processing equipment, processing the current product lot with the high priority", and later "continuing processing the previous product lot ".

Applicants' last Response also pointed out that Kashiyama does not provide an enabling disclosure of the subject matter recited in Applicants' Claim 1. The Office Action argues that Kashiyama does provide an enabling disclosure. As part of this, the Office Action argues at lines 21-28 on page 5 that a reference like Kashiyama is presumed to be operable. However, as discussed earlier, operability is not the issue, because operability and an enabling disclosure are two entirely different issues. It is possible for a reference to provide an enabling disclosure of a device that is not operable, and it is possible for a reference to provide a non-enabling disclosure of a device that is in fact operable. Further, the authority relied on by the Examiner deals with the issue of whether Kashiyama provides a proper disclosure of the Kashiyama invention, whereas Applicants' argument was that Kashiyama does not provide a proper disclosure of Applicants' invention, as recited in Applicants' Claim 1. Contrary to the assertions in the Office Actoin, there is no presumption that Kashiyama provides an enabling disclosure of Applicants' invention.

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The Office Action then goes on to quote from MPEP §2121.01, indicating that in an assertedly anticipating reference, "mere naming or description of the [claimed] subject matter is insufficient, if it cannot be produced without undue experimentation". The Office Action then asserts that:

> the *entire disclosure* of Kashiyama et al. is directed to interrupting manufacturing jobs with a system controller, including a plurality of conditions under which jobs can interrupt other jobs, based upon their respective priorities. One of ordinary skill in the art would easily, without undue experimentation, have provided for a sequence of comparison steps, specific to a particular implementation, in order to accomplish this result.

In essence, the Examiner argues that although Kashiyama does not disclose any specific procedure, much less the specific step-by-step procedure that is expressly recited in the above-quoted limitations from Applicants' Claim 1, a person skilled in the art would be able to easily come up with some suitable step-by-step procedure, without undue experimentation. However, the Office Action does not assert that the person of ordinary skill would necessarily come up with Applicants' specific step-by-step procedure, as recited in Claim 1. Moreover, as noted earlier, it is important to remember that the instant rejection is for anticipation under §102, not for obviousness under §103. Under §102, a reference must contain a clear disclosure of each and every element recited in Applicants' Claim 1. Provided that the reference discloses each and every recited element, then one may look to "undue experimentation" in order to evaluate whether the disclosed elements are all presented in sufficient detail to constitute an enabling disclosure. But where a reference fails to disclose each and every element of a claimed combination, then by definition there is no anticipation under §102, regardless of what a person skilled in the art might possibly be able to do without "undue experimentation". With reference

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to the Examiner's assertion here that a person "of ordinary skill in the art would easily, without undue experimentation, have provided for a sequence of comparison steps", there is an inherent recognition in the Office Action that Kashiyama does not disclose the specific sequence of steps recited in Applicants' Claim 1. Kashiyama thus does not anticipate Applicants' Claim 1 under §102.

Independent Claims 8, 16, 24 and 32

Independent Claims 8, 16, 24 and 32 each stand rejected under 35 U.S.C. §102 as anticipated by Fromherz. In addition, Claims 8, 16, 24 and 32 each stand rejected under §102 as anticipated by Kashiyama. These rejections are respectfully traversed. The rationale given for each of these rejections is exactly the same rationale given for the corresponding rejection of Claim 1. Further, Claims 8, 16, 24 and 32 each include limitations similar to the above-quoted limitations from Claim 1. More specifically, Claim 8 includes limitations reciting that:

> if said current product lot has a high priority, determining if a previous product lot remains in a selected unit of said processing equipment,
>
> if said previous product lot remains in the selected unit of processing equipment, determining if said previous product lot ~~is~~ has a normal priority;
>
> if said previous product lot has a normal priority, removing said previous product lot from said selected unit of processing equipment,
>
> processing the current product lot with the high priority; and
>
> upon completion of processing said current product lot with high priority, continuing processing the previous product lot.

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Claim 16 includes limitations reciting that:

> means for determining if a previous product lot remains in a selected unit of said processing equipment, if said current product lot has a high priority,
>
> means for determining if said previous product lot is has a normal priority, if said previous product lot remains in the selected unit of processing equipment;
>
> means for removing said previous product lot from said selected unit of processing equipment, if said previous product lot has a normal priority,
>
> processing the current product lot with the high priority; and
>
> means for continuing processing the previous product lot, upon completion of processing said current product lot with high priority.

Claim 24 includes limitations reciting that:

> if said current product lot has a high priority, determining if a previous product lot remains in a selected unit of said processing equipment,
>
> if said previous product lot remains in the selected unit of processing equipment, determining if said previous product lot is has a normal priority;

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if said previous product lot has a normal priority, removing said previous product lot from said selected unit of processing equipment,

processing the current product lot with the high priority; and

upon completion of processing said current product lot with high priority, continuing processing the previous product lot.

Claim 32 includes limitations reciting that:

if said current product lot has a high priority, determining if a previous product lot remains in a selected unit of said processing equipment,

if said previous product lot remains in the selected unit of processing equipment, determining if said previous product lot is has a normal priority;

if said previous product lot has a normal priority, removing said previous product lot from said selected unit of processing equipment,

processing the current product lot with the high priority; and

upon completion of processing said current product lot with high priority, continuing processing the previous product lot.

Therefore, for the same basic reasons discussed above in association with Claim 1, it is respectfully submitted that Claims 8, 16, 24 and 32 are not anticipated under §102 by Fromherz or by Kashiyama, and notice to that effect is respectfully requested.

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Dependent Claim 7

Dependent Claim 7 stands rejected under 35 U.S.C. §102 as anticipated by either Fromherz or Kashiyama. These grounds of rejection are respectfully traversed, for the following reasons. As noted above, MPEP §2131 specifies that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim. Claim 7 recites that:

> . . . said product lots are integrated circuit substrates and said units of said processing equipment are integrated circuit fabrication equipment.

Neither Fromherz nor Kashiyama discloses any "integrated circuit fabrication equipment" or any "integrated circuit substrates". The Office Action admits that Fromherz and Kashiyama each fail to specifically disclose any "integrated circuit fabrication equipment" or any "integrated circuit substrates". But at lines 6-9 on page 4, the Office Action asserts that Fromherz is directed to the control and management of an automated manufacturing system, and that integrated circuit fabrication facilities are an extremely well-known type of automated manufacturing system. Similarly, at lines 6-9 on page 6, the Office Action asserts that Kashiyama is directed to the control and management of an automated production system, and that integrated circuit fabrication facilities are an extremely well-known type of automated production system. However, Applicants respectfully point out that the rejections of Claim 7 are for anticipation under §102, not for obviousness under §103. Under §102, a reference must contain a disclosure of each and every element recited in Applicants' Claim 7. Since the Office Action admits that Fromherz and Kashiyama each fail to specifically disclose either "integrated circuit fabrication equipment" or any "integrated circuit substrates", Fromherz and Kashiyama do not disclose each and every element recited in Claim 7, and Claim 7 is not anticipated under §102 by either

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Fromherz or Kashiyama. Claim 7 is thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims 15, 23, 31 and 39

Dependent Claims 15, 23, 31 and 39 each stand rejected under 35 U.S.C. §102 as anticipated by either Fromherz or Kashiyama. These rejections are respectfully traversed, for the following reasons. These claims each include limitations similar to the above-quoted limitations from Claim 7. In particular, Claims 15, 23, 31 and 39 each include limitations reciting that:

> . . . said product lots are integrated circuit substrates and said units of said processing equipment are integrated circuit fabrication equipment.

As noted above, MPEP §2131 specifies that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim. As also noted above, neither Fromherz nor Kashiyama discloses any "integrated circuit fabrication equipment" or any "integrated circuit substrates". Therefore, since Fromherz and Kashiyama each fail to disclose each and every element recited in Claims 15, 23, 31 and 39, these claims are not anticipated under §102 by either Fromherz or Kashiyama. Claims 15, 23, 31 and 39 are thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-6, Claims 9-14, Claims 17-22, Claims 25-30, and Claims 33-38 respectively depend from Claim 1, Claim 8, Claim 16, Claim 24 and Claim 32, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 1, 8, 16, 24 and 32.

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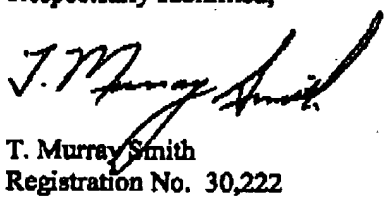
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Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Date: August 16, 2005

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Enclosures: None

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